

REMARKS

Claims 16, 18-23 and 49 are pending. Claims 1-15, 17 and 24-48 have been canceled without prejudice. Claim 16 has been amended. Claim 49 is new. Support for the amendment to claim 16 and new claim 49 can be found in the specification and claims as originally filed.

Importantly, the claim amendments and cancellations are being made solely to claim more clearly the invention and to expedite the prosecution of the instant application. The Applicants expressly reserve the right to further prosecute the same or similar claims in subsequent patent applications claiming the benefit of priority to the instant application. 35 U.S.C. § 120; and 35 U.S.C. § 121.

Favorable consideration is respectfully requested in view of the foregoing amendments and following remarks.

Claim Rejections based on 35 U.S.C. § 112¶1

Claims 16 and 18-23 stand rejected under 35 U.S.C. 112, first paragraph, based on the Examiner's contention that the specification fails to comply with the enablement requirement. The Applicants respectfully traverse.

Claim 16 has been amended to incorporate the limitation of claim 17. Therefore, in all of the pending claims step (a) requires "contacting an aqueous fibrous protein solution with a solvent that is not miscible with water, wherein the fibrous protein is selected from the group consisting of silk, collagens, keratins, actins, chorions, and seroins." Because the Examiner has merely objected to claim 17, as discussed in greater detail below, the Applicants respectfully contend that all of the pending claims comply with the requirements of 35 USC 112¶1.

Nevertheless, in the name of thoroughness the Applicants wish to refine their position with respect to the claim limitation relating to "a solvent that is not miscible with water." The Examiner asserts that the specification does not provide enablement for water-immiscible solvents other than hexane, chloroform and iso-amyl alcohol. However, the examples of solvents that are "not miscible with water" provided in the application - hexane, chloroform, and iso-amyl alcohol - are of varying molecular structures, molecular weights, hydrogen-bonding capabilities, and polarities: hexane is a hydrophobic, less-dense-than-water, low-molecular-

weight straight-chain alkane; chloroform is a somewhat-acidic, more-dense-than-water, high-molecular-weight halocarbon; and iso-amyl alcohol is a somewhat-acidic, hydrogen-bond-donating, hydrogen-bond-accepting, polar-protic alcohol. However, with respect to the claimed invention they share one critical feature – immiscibility with water.

Importantly, based on this range of working examples, a person skilled in the art could readily conceive of a myriad of alternative water-immiscible solvents from which, with only routine experimentation, additional suitable solvents for use in the claimed methods could be identified. Thus, the Applicants respectfully contend that, armed with the direction provided by the specification, a person of ordinary skill in the art could select suitable water-immiscible solvents for use in the claimed methods with only routine experimentation. Therefore, the Applicant respectfully contends that the experimentation necessary to make and use the claimed invention is not undue.

Accordingly, the Applicants respectfully request withdrawal of the claim rejections under the enablement requirement of 35 U.S.C. § 112¶1.

Claim Objections/Allowable Subject Matter

Claim 17 has been objected to as being dependent upon a rejected base claim. The Applicants gratefully acknowledge the Examiner's indication that claim 17 would be allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claims. In order to expedite prosecution, the Applicants have amended independent claim 16 to incorporate all of the limitations of claim 17. Consequently, the Applicants believe that all of the pending claims are in condition for allowance.

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The Applicants believe they have provided the required fee in connection with the filing of this paper. Nevertheless, the Commissioner is hereby authorized to charge any additional fees due in connection with the filing of this paper to our Deposit Account, No. 06-1448, reference TUV-031.01.

CONCLUSION

The Applicants believe that the pending claims are in condition for allowance. If a telephone conversation with Applicants' Agent would expedite the prosecution of the above-identified application, the Examiner is urged to call the undersigned at (617) 832-1000.

Respectfully submitted,
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